

The Issue

As the Examiner knows, establishing *prima facie* obviousness of a claimed invention requires a showing by convincing reasoning that the prior art teaches or suggests all the claim elements. The only prior art (Vin, et al.) is acknowledged not to teach all these elements and is incompatible with the non-taught claim elements. Therefore, can the non-teaching, incompatible Vin reference be shown by convincing reasoning to suggest all claimed elements?

It is submitted that it cannot.

Discussion

This patent application has two independent claims -- apparatus claim 55 and method claim 196. The patentability issues for both independent claims are similar. Also, claim 55 partially corresponds to claim 3 (claim 9 as filed) of PCT application PCT/US94/02961. The Examiner, as IPEA previously rejected claim 3 of this PCT application as being obvious in the light of Vin, et al.¹

¹ IEEE Computer Magazine, October 1991. Vin et al. "Multimedia Conferencing in the Etherphone Environment. This was the only reference cited against corresponding PCT claims.

Vin does not teach the claimed invention.

As IPEA, the Examiner acknowledged that Vin does not teach the use of codecs.

Accordingly, the Examiner admits that Vin does not teach routing a decompressed audio-visual (AV) signal from a first to a second location via a third location, without

decompression at the third location. This routing is an element in all claims in this

application. Thus at least one claimed element is not taught. The onus is on the Examiner in

establishing *prima facie* obviousness, to show that the prior art *teaches or suggests* the

claimed configuration.² But the Examiner has admitted that the prior art does not teach all

the limitations. It follows, therefore, that if the Examiner is to succeed in showing *prima*

facie obviousness, he must show that the prior art *suggests* the invention.

Vin does not suggest all claim elements.

A showing that the prior art *suggests* all the claimed elements must be made by a convincing

line of reasoning.³ But, this cannot be done.

Vin, which does not teach the use of codecs nor the claimed signal routing feature, cannot

contain the essential teaching or suggestion to make the claimed combination with a

reasonable expectation of success.⁴ For how can one be led to the invention, and have a

² *In re: Royka*, 490 F.2d 981, 180 USPQ 580 CCPA 1974 as cited in the MPEP § 143.03.

³ *Ex parte Clapp* 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985) as cited in the MPEP § 2142.

⁴ *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991) as cited in the MPEP § 2142.

reasonable expectation of success, by the Vin reference, a reference in which no consideration is given to routing signals between destinations via other destinations and in which the necessary digital switching layer between digital lines and the codec and the analog switching layer on the analog side of the codec are totally absent?

Vin cannot be combined with other references.

The Examiner may, instead, argue that the AV signal routing feature could be derived from other art areas and combined with the Vin teaching. This argument will also fail.

First, the fact that references can be combined *does not* render the combination obvious unless the prior art suggests the desirability of the combination.⁵ Thus, the Examiner must supply prior art that both teaches the missing element *and* suggests the desirability of combination with Vin,

Second, an argument that Vin can be combined with prior art data routing systems will be to no avail. Such data transmission is achieved by routing separate data packets and queuing these. Thus, the data delivery is often not in real-time. Video conferencing, on the other hand, must be in real-time. If not, the communications will be very difficult.

⁵ *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990) as cited in the MPEP § 2143.01.

Thus, the combination of Vin's AV signals with such incompatible data routing technology will lead to a system that is unworkable. The necessary expectation of success and suggested desirability of the combination will not be present. Accordingly, it cannot be obvious to combine Vin with incompatible data routing technology and the burden of providing a convincing line of reasoning for such combination cannot be met.

The claimed invention has significant advantages not evident in the prior art.

In addition, the claimed routing method has significant non-obvious advantages.

The quality of the reproduced audio and video is very significant in videoconferencing systems. Delays in audio transmission and "jerky" video images are unacceptable. These typically result from the digital transmission of audio and video where the signals are compressed, transmitted and then decompressed for display. Another delay is introduced every additional time a signal must be compressed and decompressed. Thus even one additional decompression/recompression iteration is objectionable. It follows, therefore, the claimed invention is significant. It reduces the number decompression/recompression iterations for a given AV signal and improves quality.

For all the above reasons, therefore, Applicants, submit that the Examiner has not and cannot meet the burden of showing this invention is *prima facie* obvious. Accordingly, Applicants, request allowance of these claims at the Examiner's earliest convenience. Should the

Supplemental Amendment

Docket: VCOR-001/02US

Examiner believe a further conference will expedite the allowance of this application, contact with the undersigned is requested.

Respectfully submitted,



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